

REMARKS

The allowance of claims 1 – 5 is acknowledged. Applicant believes that the Statement of Reasons for Allowance in this case is improper as it merely copies each limitation of the claim into the reasons for allowance. While applicant believes that the claims are allowable, applicant does not agree patentability resides in each feature, exactly as expressed in the claims, nor that each feature is required for patentability.

Claim 51 stands rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner stated:

The preamble of claim 51 states “An integrated circuit testing apparatus, comprising at least two of the following circuits” in which the list of potential alternatives can vary resulting in ambiguity in the claim. For example, because the testing apparatus comprises at least two of the cited circuits it is possible to have the first and second test circuit, a second and third test circuit, a first and fourth test circuit and so on. Thus, the exact metes and bounds of the claim cannot be ascertained. In addition, because the integrated circuit testing apparatus can comprise any two of the circuits cited in the body it would be possible to have “a third test circuit...” and “a fourth test circuit...” which would be confusing because there would be no first and second test circuits before the third and fourth test circuits.

It is respectfully submitted that the metes and bounds of claim 51 can adequately be determined by a person possessing ordinary skill in the art. The preamble of claim 51 recites “An integrated circuit testing apparatus, comprising at least two of the following circuits” and the body of claim 51 recites four different test circuits. Thus, it should be apparent to one skilled in the art that the integrated circuit testing apparatus as recited by claim 51 may be comprised of any one of six combinations of test circuits (i.e., test circuits 1-2, 1-3, 1-4, 2-3, 2-4, and 3-4).

Additionally, claim 51 is amended to remove any reference to “first”, “second”, “third”, and “fourth”. Thus, it is no longer possible to have, for example, “a third test circuit...” and “a fourth test circuit...” without first and second test circuits before the third and fourth test circuits.

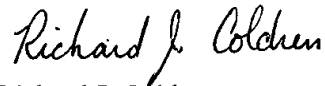
For the reasons discussed above, it is believed that claim 51 is in condition for allowance. Accordingly, it is respectfully requested that the rejection of claim 51 pursuant to 35 U.S.C. §112, second paragraph, be withdrawn.

Applicants have made a diligent effort to place the claims in condition for allowance. Accordingly, a Notice of Allowance for claims 1 – 5 and 51 is respectfully requested. If the Examiner is of the opinion that the instant application is in condition for disposition other than through allowance, the

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Examiner is respectfully requested to contact applicants' attorney at the telephone number listed below so that additional changes may be discussed.

Respectfully submitted,



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